

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
)	
Frank A. HUNLETH et al.)	Group Art Unit: 2176
)	
Application No.: 10/768,432)	Examiner: Henry W. Orr
)	
Filed: January 30, 2004)	Confirmation No.: 8731
)	
For: CONTROL FRAMEWORK WITH)	
A ZOOMABLE GRAPHICAL)	
USER INTERFACE FOR)	
ORGANIZING, SELECTING)	
AND LAUNCHING MEDIA)	
ITEMS)	

CORRECTED APPEAL BRIEF IN RESPONSE TO NOTIFICATION OF NON-
COMPLIANT APPEAL BRIEF

Sir:

In response to the Notification of Non-Compliant Appeal Brief mailed on March 16, 2009, please replace the Argument section (Section vii) with the new Argument section enclosed herewith, which presents corrected headings and subheadings.

(vii) **ARGUMENT**

I. Rejection of Claims 1, 4, 5, 10, 13-21, 23-27, 29-30, 32, 33, and 47-54 as unpatentable over Daily, Duarte and Twerdahl is improper

IA. Finality of the last Office Action is Improper

The independent claims have been discussed above. As independent Claim 53 recites representative features that are not found in the applied art, the following discussion is based on Claim 53. However, it applies equally to all of the independent claims.

One of the features recited by independent Claim 53 is transitioning from a current semantic level to a different semantic level while displaying a first image at both levels.

Appellants's arguments presented in the response filed on May 23, 2008, indicated that Twerdahl does not teach or suggest the above noted feature. More specifically, Appellants indicated that a central object 218 in Figure 2 is not identical to a central object 318 in Figure 3 in Twerdahl, contrary to the examiner's assertion.

In response to this argument, the Final Office Action specifically states on page 18, third full paragraph, that "Twerdahl teaches '**A second central object 318 can be the same as the first central object 218.**'" Appellants note that the Final Office Action underlines and highlights this statement for rejecting a feature recited by all independent claims.

Also, it is noted that the Final Office Action did not provide other arguments for justifying why the above claimed feature is rejected. Thus, the Final Office Action relies entirely on the above quoted language of Twerdahl for rejecting the claims.

The Request for Reconsideration filed on November 14, 2008, indicated that, although Twerdahl includes the statement made by the Final Office Action, this disclosure in paragraph [0020] of Twerdahl does not find support in the provisional application No. 60/467,164, from which Twerdahl claims priority.

In this respect, the provisional application only discloses on page 3, first full paragraph, last two lines, that “[t]he central object 318, depicting an ‘up one level’ symbol, may be selected by the user to return to the first level menu 200.” However, Figures 2 and 3 of the provisional application clearly show the central object 318 being different from the central object 218.

Further, the Request for Reconsideration indicated that because paragraph [0020] of Twerdahl, on which the Final Office Action relied, does not find support in the provisional application, this paragraph of Twerdahl is not prior art as this disclosure has a filing date of April 16, 2004, which is after the actual filing date of this application, i.e., January 30, 2004.

In other words, Appellants indicated that the portion of Twerdahl on which the Examiner relied during the prosecution is not prior art.

Tacitly admitting this deficiency of the Final Office Action, the Advisory Action of December 10, 2008, states on page 2, second to last full paragraph, that another section of the provisional application supports the former position of the Examiner.

In addition, the Examiner uses the language of a 103 rejection for indicating that one of ordinary skill in the art, after reading the newly indicated paragraph of the provisional application of Twerdahl, would consider obvious the former position of the Examiner based on the provisional application.

Not addressing the merits of this new argument in this section of the Appeal Brief, Appellants only indicate in this section that it is unfair to be presented with a new position in an Advisory Action, which does not offer the Appellants the chance to respond to such arguments. In other words, given the reliance of the Examiner that one claimed feature is obvious based on the provisional application of Twerdahl (which was not relied upon in the Final Office Action), it would have been fair to withdraw the finality of the last office action and offer the Appellants the chance to argue the Examiner's new position, which was not necessitated by amendments to the claims.

At least for these reasons, it is believed that the Final Office Action is improper and should be withdrawn.

IB. Rejection of Claims 1, 4, 5, 10, 13-21, 23-27, 29-30, 32, 33, and 47-54 under the combination of Daily, Duarte and Twerdahl is improper

a. Duarte does not teach or suggest current and different semantic levels

Independent Claim 53 subject matter has been discussed above.

The standard under which obviousness, or non-obviousness, must be decided was set forth in *Graham v. John Deere*, 383 U.S. 1 (1966). Therein, the court indicated that a proper review of the question involves (a) determining the scope and content of the prior art, (b) determining the level of ordinary skill in the prior art, (c) the differences between the claimed invention and the prior art and, if present (d) secondary considerations, such as commercial success. When combining the teachings of a first prior art reference with teachings from a second prior art reference, some reason or motivation for one of ordinary skill in the art to have made the combination must be identified. *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340 (Fed. Cir. 1998). The recent case of *KSR v. Teleflex*, 550 U.S. 398 (2007), did not absolve decision makers of the need for providing a reason or motivation to combine, but did explain that the sources or rationale to be used were not subject to rigid formulation, e.g., indicating that courts can “take account of inferences and creative steps that a person of ordinary skill in the art would employ”. These tenets of patent law are applied below to the circumstances of the rejection of the claims involved in this appeal.

Turning to the applied art, the Final Office Action recognizes in the last paragraph on page 3 that Daily does not teach or suggest “a means for transitioning as recited in

claim 1” and relies on Duarte for teaching such a means. More specifically, the Final Office Action considers that highlighting an icon 101 (i.e., camera icon) in Figure 11 of Duarte, a size of that icon 101 is increased by the highlighting operation. The Final Office Action considers that Duarte describes at column 8, lines 24-38, that by highlighting the icon 101, this icon “stands out from the other icons.”

However, this disclosure of Duarte does not teach or suggest changing “the location of the first image ... such that the first image translates from a first location at the current semantic level to a second location at the different semantic level,” as recited by Claim 53. Even more, Duarte does not transition from a current semantic level to a different semantic level but rather remains at a same level.

In this respect, Duarte discloses at column 8, lines 24-38 that “a highlight region (represented by dotted line **102**) remains in a consistent area on the display and the icons on the loop menu move through that region.” To account for an icon moving from a current semantic zooming to a different semantic zooming, the Final Office Action considers that displaying a first icon in the highlight region 102 together with a “graphical indication” (see area 103 in Figure 11 of Duarte) associated with the first icon constitutes the claimed current semantic zooming and displaying a second icon in the highlight region 102 with its associated graphical indication constitutes the claimed different semantic zooming.

Appellants respectfully submit that such an interpretation of the claimed “semantic zooming” is inaccurate. The semantic zooming has been defined in the

specification, for example, in paragraph [0065]. In this regard, it is noted that although claims during examination are given their broadest reasonable interpretation in order to facilitate precision in claiming, that interpretation must be "consistent with the specification, [and] claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." In re Bond, 910 F.2d 831, 833 (Fed. Cir. 1990); see also Phillips v. AWH Corp., 415 F.3d 1303, 1313 (Fed. Cir. 2005) ("[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question.").

Appellants respectfully submit that a person of ordinary skill in the art would not consider Figure 11 and corresponding disclosure in Duarte as showing plural semantic zooming as suggested by the Examiner. For these reasons, it is believed that the combination of Daily and Duarte fails to teach or suggest transitioning from a current semantic level to a different semantic level as recited by the claims.

Furthermore, as recognized by the Final Office Action on page 4, second full paragraph, Duarte fails to display the first image, at the different semantic level, without other images that were displayed with the first image at the current semantic level.

b. Twerdahl does not teach or suggest displaying a same image at current and different semantic levels

As noted above, the Advisory Action refers for the first time during prosecution to an unidentified portion of the provisional application of Twerdahl for indicating that a

central object 218 may be the same with a central object 318. For the record, it is noted that the portion referred to by the Advisory Action is found in the provisional application at page 2, lines 7-15.

Twerdahl discloses a radial menu interface for handheld computing devices (see Title and abstract of non-provisional application). Twerdahl shows in Figure 2 (which is the same for the provisional and non-provisional application) plural first level menu items 202 to 216 that are disposed around a central object 218 and discloses, in the first full paragraph on page 3 of the provisional application, that upon selection of a first level menu item a second level menu is generated.

Appellants note that elements 202 to 216 are “menu items” while element 218 is a “central object.” Thus, an element 202 is different from an element 218 in the sense that selecting an element menu item 202 to 216 generates the second level menu while selecting the central object 218 does not generate the second level menu.

In other words, asserting *arguendo* that the central object 218 corresponds to the claimed first image as asserted by the Final Office Action and the central object 218 is identical to the central object 318 in Twerdahl, activating the central object 218 fails to generate the second level menu, which is different from the claims.

However, the central object 218 is different from the other central object 318 as clearly shown by the figures of the provisional application. In addition, there is no suggestion in the provisional of Twerdahl that these two central objects are identical as suggested by the Advisory Action.

Therefore, it is respectfully submitted that the combination of Daily, Duarte and Twerdahl does not teach or suggest displaying a same image at the current semantic zooming and at a different semantic zooming as recited by the independent claims.

These arguments apply to all of the independent claims and, therefore, also to the dependent claims which have been rejected.

II. Rejection of Claim 28 under the combination of Daily, Duarte, Twerdahl and Butler is improper

Appellants respectfully submit that the rejection of dependent Claim 28 is improper for the reasons discussed above with regard to independent Claim 53.

Conclusions

As the Examiner has failed to establish any reasonable motivation to combine the references and even if they could, for some unknown reason, be combined, the reference teachings would fail to suggest all the limitations of the rejected claims and thus, reversal of all outstanding rejections is respectfully requested.

Respectfully submitted,
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